



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,581	12/12/2003	Sudarshan Palliyil	JP920030275US1	2542
39903	7590	05/23/2008	EXAMINER	
IBM ENDICOTT (ANTHONY ENGLAND) LAW OFFICE OF ANTHONY ENGLAND PO Box 5307 AUSTIN, TX 78763-5307			ZEE, EDWARD	
		ART UNIT	PAPER NUMBER	
		2135		
		MAIL DATE	DELIVERY MODE	
		05/23/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/735,581	PALLIYIL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	EDWARD ZEE	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 07 March 2008.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 49-60 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 49-60 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

### **DETAILED ACTION**

1. This is in response to the amendments filed on March 7<sup>th</sup>, 2008. Claims 1-48 have been cancelled; Claims 49-60 have been added; Claims 49-60 are pending and have been considered below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 7th, 2008 has been entered.

#### ***Claim Objections***

3. Claim 49 is objected to because of the following informalities: the Examiner notes the term "operative" in line 4 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention and should be amended to "configured" or the like. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 57-60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 57-60 at first appear to be direct towards a computer program product which is stored on a computer readable medium. However, in line 2 of Claim 57, the “computer program product” appears to merely comprise of “instructions for execution”. Thus, Claims 57-60 are drawn to software per se. Software is not a series of steps or acts and this is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a compilation of matter. Thus, software by itself does not fall within any of the four categories of invention. Therefore, Claims 57-60 are not statutory.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 49-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glover (6,763,466) in view of Muttik et al. (2003/0046611).**

***Claims 49, 53 and 57:*** Glover discloses an apparatus, method and computer program product comprising the steps of:

- a. scanning the resources for viruses(*ie. anti-virus program scans files for known viruses*) in multiple instances(*ie. when the file is next accessed, etc.*) and computing hash values for the resources(*ie. AV state information*) [column 6, lines 17-52];

b. classifying each of the resources as higher (*ie. if there is a change in AV state information*) or lower priority (*ie. if there is no change*) responsive to whether the hash values for each resource are equal for the first and second update times and whether the scanning determines each resource is virus free in both the first and second scanning instances (*ie. if the compared current AV state information is different from the stored AV state information*) [column 6, lines 17-52];

c. and for a next scanning instance the resources classified as higher priority are scanned before the ones of the resources classified as lower priority (*ie. if there is a change rescan file and update AV state information, if there is no change don't rescan*) [column 6, lines 17-52].

However, Glover does not explicitly disclose:

- a. updating, at successive update times, virus definitions for resources stored on a data processing system;
- b. scanning the resources for viruses in first and second scanning instances responsive to the virus definitions updated at respective first and second ones of the update times.

Nonetheless, Muttik et al. discloses a similar invention and further discloses updating virus definitions and scanning for viruses in response to the updating (*ie. stop scanning while defining data is updated and resume scan using the updated information*) [page 1, paragraph 0011].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to further modify the invention disclosed by Glover with the teachings of Muttik et al., in order to perform a more thorough scan with the most up to date information, as suggested by Muttik et al. [page 1, paragraph 0008].

**Claims 50, 54 and 58:** Glover and Muttik et al. disclose the invention of claims 49, 53 and 57, and Glover further discloses that the data processing system has activity intervals of higher(*ie. if AV state information indicates that a file should be rescanned, the file is scanned*) and lower activity(*ie. AV state information indicates no change*) and in the next scanning instance the scanning of the ones of the resources classified as lower priority is performed during one of the lower activity intervals [column 8, lines 7-25].

**Claims 51, 55 and 59:** Glover and Muttik et al. disclose the invention of claims 49, 53 and 57, and Glover further discloses that a scanning interval is defined from a time of the first scanning instance until a time of the second scanning instance and the classifying is further responsive to whether the scanning interval exceeds a predetermined threshold(*ie. scheduled scans*) [column 8, lines 7-25].

**Claims 52, 56 and 60:** Glover and Muttik et al. disclose the invention of claims 49, 53 and 57, and Glover further discloses that in the next scanning instance the ones of the resources classified as lower priority are not scanned(*ie. if AV state information doesn't change, file is not scanned*) [column 6, lines 17-52].

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 49-60 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWARD ZEE whose telephone number is (571)270-1686. The examiner can normally be reached on Monday through Thursday 9:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EZ  
May 17<sup>th</sup>, 2008  
/KIMYEN VU/  
Supervisory Patent Examiner, Art Unit 2135